

**REMARKS:**

Claims 1-34 remain pending in the application.

Claims 1-34 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,038,668 to Chipman, et al in view of U.S. Patent No. 6,094,680 to Hokanson and U.S. Patent No. 6,081,840 to Zhao. This rejection is respectfully traversed for the reasons discussed below.

**REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 1-34 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,038,668 to Chipman, et al ("Chipman") in view of U.S. Patent No. 6,094,680 to Hokanson ("Hokanson") and U.S. Patent No. 6,081,840 to Zhao ("Zhao"). Thus, the present Office Action maintains the same rejection set forth in the previous Office Action dated 3 June 2005.

The present Office Action, in the first paragraph under the heading "RESPONSE TO ARGUMENTS," states the following:

As a means of providing further clarification as to what is taught by the references used in the first Office Action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

However, the entirety of the Office Action has been reviewed and no such further clarification has been found.

For example, the text of the present Office Action under the heading "Claim Rejections – 35 USC § 103" that sets forth the present rejection is **identical** to the text of the previous Office Action under the heading "Claim Rejections – 35 USC § 103," except for a sole new paragraph, which requests Applicant to consider the cited references in their entirety.

The remaining paragraphs under the heading "RESPONSE TO ARGUMENTS" merely set forth general legal arguments related to obviousness. No clarification regarding the substance of the references, particularly as it relates to the Applicant's previously-presented arguments, is found.

The MPEP sets forth the standards for examination of patent applications. MPEP 707.07(f) is set forth under the heading "Answer All Material Traversed." MPEP 707.07(f) instructs examiners to answer the substance of an applicant's arguments:

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

...

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and **answer the substance of it.**

(Emphasis added). Thus, a proper Office Action should not only take note of the applicant's arguments, but should also include an answer to the substance of those arguments.

It is respectfully submitted that the present Office Action merely notes Applicant's arguments without answering the substance of the arguments. Thus, it is respectfully submitted that the present Office Action is defective for failing to comply with the MPEP and should be withdrawn.

For the convenience of the Examiner, the previously-presented arguments are provided below, updated to include parallel cites to the present Office Action. It is respectfully requested that if the present rejection is maintained, that the next Office Action include clarification that directly answers the arguments previously presented and presented again below.

Thus, the present rejection is respectfully traversed for at least the same reasons presented in the previous Response filed on 26 August 2006 in the present Application.

With respect to claim 1, this claim recites *inter alia*:

**generating a request history for each of the users** based on the monitoring of the requests for product data by the users;  
identifying the location of a particular user;  
**determining**, in response to monitoring requests for product data by the particular user **using the request history for the particular user**, that the **product data requested by the particular user should be migrated** from a seller database to a storage location that is closer to the identified location of the particular user than the seller database

(Emphasis added.) Thus, claim 1 requires generation of a request history for each user. Claim 1 further requires determining whether product data should be migrated based on the request history of the particular user.

Regarding Chipman, the Office Action acknowledges that Chipman fails to disclose generating a request history for each of the users based on monitoring the requests of the users.<sup>1</sup> It necessarily follows that Chipman likewise fails to disclose using such a user request history for determining whether product data should be migrated.

Regarding Hokanson, it is respectfully submitted that Hokanson fails to disclose generating a request history for each of the users based on monitoring the requests of the users. The Office Action alleges that Hokanson discloses monitoring user demand.<sup>2</sup> However, Hokanson actually teaches monitoring of general demand for particular data. For example, Hokanson discloses that a local server “monitors the number of users requesting the movie information.”<sup>3</sup> This monitoring of demand for data is different from generating a request history for each of the users. Further, monitoring demand for data as taught by Hokanson does not inherently include generating request history for each user. It necessarily follows that Hokanson likewise fails to disclose using such a user request history for determining whether product data should be migrated. In fact, Hokanson teaches away from this concept. Instead of migrating data based on a user’s request

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<sup>1</sup> Office Action dated 3 June 2005, page 4, lines 20-21; Office Action dated 18 November 2005, page 7, lines 11-12.

<sup>2</sup> Office Action dated 3 June 2005, page 4, lines 21-23; Office Action dated 18 November 2005, page 7, lines 112-14.

<sup>3</sup> Hokanson, col. 7, lines 43-44.

history, Hokanson teaches allocation of data based on a cost analysis. For example, Hokanson discloses:

If the users at a local network cite request a particular resource that is available only from a remote network cite, the network manager *weighs the cost of supplying the requested resource against the cost of supplying the same request were it offered locally*. If it is cheaper to offer the resource locally (e.g., many users are requesting the same remotely located resource), then the *network manager might relocate the requested resource to the local network cite* where it is being requested *so long as the new allocation of resources does not upset a cost/availability balance* for the local network cite.

(Emphasis added.) Thus, not only does Hokanson fail to disclose generation of a request history for a user, Hokanson also teaches allocation of data according to where the data is cheapest to maintain rather than basing migration on a user's request history.

Regarding Zhao, it is respectfully submitted that Zhao, like Chipman and Hokanson, fails to disclose generating a request history for each of the users based on monitoring the requests of the users. The Office Action alleges that Zhao discloses "monitoring usage patterns of data."<sup>4</sup> Actually, Zhao discloses tracking the number of times a data file collection has been accessed.<sup>5</sup> This tracking performed by the Zhao system is not the same as generating a request history for each user. Further, the tracking performed by Zhao does not inherently require generating a request history for each of the users. It necessarily follows that Zhao likewise fails to disclose using such a user request history for determining whether product data should be migrated.

Thus, Chipman, Hokanson, and Zhao all fail to disclose generation of a request history for each user, and also fail to disclose determining whether product data should be migrated based on the request history of the particular user. Accordingly, if one were to consider the proposed combination of Chipman, Hokanson, and Zhao, the combined teachings would still fail to disclose all of the limitations of claim 1.

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<sup>4</sup> Office Action dated 3 June 2005, page 4, lines 25-26; Office Action dated 18 November 2005, page 7, line 18.

<sup>5</sup> See, e.g., Zhao, col. 3, lines 9-11.

Further, regarding the proposed combination, the MPEP provides that “[t]o establish a prima facie case of obviousness....there must be some suggestion or motivation...to modify the reference or to combine reference teachings.”<sup>6</sup> To this end, the MPEP also provides that “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”<sup>7</sup>

With this standard in mind, it is respectfully submitted that modifying Hokanson in view of Zhao as proposed would render Hokanson unsatisfactory for its intended purpose. Hokanson specifically states that “[t]his invention concerns methods and systems for managing and providing resources over a network **in a manner which balances availability** of the resources to meet user demand **and the cost** to make the resources available.”<sup>8</sup> Thus, the purpose of the Hokanson invention is to balance the availability of resources against the cost of making such resources available. Zhao, on the other hand, requires transfer of data files when the number of times the files have been requested exceeds a fixed threshold.<sup>9</sup> So, modification of the Hokanson invention to incorporate the teachings of Zhao would result in the Hokanson invention always transferring data that had been accessed a predetermined number of times. This modification would obviate the cost balance aspect of Hokanson, since data would be automatically transferred after a predetermined number of accesses. Thus, modifying Hokanson in view of Zhao would render Hokanson unsatisfactory for its intended purpose. Therefore, since the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification of Hokanson in view of Zhao.

With respect to dependent claims 2-16, since these claims depend from independent claim 1, the discussion above applies equally to claims 2-16. Accordingly, claims 2-16 cannot be rendered obvious by the proposed combination of Chipman, Hokanson, and Zhao for at least the reasons discussed above in connection with claim 1.

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<sup>6</sup> MPEP 2143.

<sup>7</sup> MPEP 2143.01, citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

<sup>8</sup> Hokanson, col. 2, lines 31-34 (emphasis added).

<sup>9</sup> See, e.g., Zhao, col. 3, lines 9-15.

With respect to claims 17, 33, and 34, each of these claims recites limitations similar to those discussed above in connection with claim 1. Accordingly, claims 17, 33, and 34, as well as claims 18-32, which depend from claim 17, cannot be rendered obvious by the proposed combination of Chipman, Hokanson, and Zhao for at least the reasons discussed above in connection with claim 1.

In light of the discussion above, it is respectfully submitted that claims 1-34 are in condition for allowance. Accordingly, Applicants respectfully request that the rejection of claims 1-34 under 35 U.S.C. § 103(a) be reconsidered and that claims 1-34 be allowed.

### **THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*,

916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991; *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**

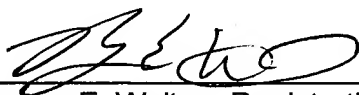
In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

The undersigned hereby authorizes the Director to charge any fees that may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

21 FEB 2006  
Date

  
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